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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/386,813 02/08/95 HUGLUND B 361427-2000

EXAMINER

IM62/0104

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FIGUEROA, J	
ART UNIT	PAPER NUMBER

1772

23

DATE MAILED:

01/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/386,813

Applicant(s)
Hoglund et al.

Examiner
John J. Figueroa

Group Art Unit
1772



☒ Responsive to communication(s) filed on Oct 14, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 13-28 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1772

RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The 35 U.S.C. §112 rejection of claim 26 of record in Paper #20, Page 2, Paragraphs #2, has been withdrawn due to Applicant's amendment in Paper #22.

REJECTIONS REPEATED

2. The 35 U.S.C §103 rejection of claims 13-28 as unpatentable over admitted prior art in view of Bridgeford is repeated for reasons previously of record in Paper #20, Page 3, Paragraph #6.

ANSWERS TO APPLICANT'S ARGUMENTS

3. Applicant's arguments filed in Paper #22 the U.S.C. §112 rejection of record have been considered but are moot since the rejection has been withdrawn.
4. Applicant's arguments filed in Paper #22 regarding the 35 U.S.C. §103 rejection of claims 13-28 as unpatentable over admitted prior art in view of Bridgeford have been carefully considered but are deemed unpersuasive.

Applicant's claimed method is not patentably distinct from Bridgeford's disclosed method for forming thin-walled cellulose sausage casings.

Art Unit: 1772

Applicant's arguments concerning "the materials identified as ... prior art relied upon by the board ... not appear[ing] to be of [applicant's claimed] character" are misguided since they amount to a general allegation that the claims define a patentable invention without *specifically* pointing out how the language of the claims patentably distinguishes them from the Board rejection. Applicant has not specifically disclosed which "materials" discussed in the Board rejection is being compared to the method recited in applicant's claim 2. In fact, Applicant relies on the "Table on page 6 of the present application" to justify its position regarding the prior art being an "inadequate basis" for supporting the Board's position. Since there is no Table on page 6 in the present application, Applicant has failed to substantiate its contention that the prior art does not trend to casings of lesser weight.

Applicant's arguments regarding Bridgeford "not [being] sufficient to remedy the shortcomings of the ... 'admitted' prior art" are misdirectional. Applicant's ensuing discussion regarding Bridgeford does not take into consideration the Board's analysis of said patent *in combination* with the admitted prior art. Instead, applicant's assertions regarding e.g. Bridgeford's disclosed basis weight ("about 15 to 25 grams/square meter of cellulose") being different from applicant's recited basis weight does not address the Board's finding that "those of ordinary skill ... had an economic incentive to reduce *basis weight* of cellulose" and it "would have been obvious ... from a combined consideration of the applied teachings, to effect applicant's claimed methods". [emphasis added] (*See* Board Decision, page 7, lines 2-8 and page 8, line 1 to page 9, line 7) Therefore, applicant has failed to address the true test which is what

Art Unit: 1772

the combined teachings of the reference and admitted prior art would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references and/or admitted prior art. See *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

However, specifically regarding said basis weights, it is the Examiner's position that Bridgeford's disclosed basis weight of "*about* 15 to 25 grams/square meter of cellulose" (as admitted by applicant in paper #20, page 4, line 15-18) encompasses applicant's recited amended claim 13 and 26-27 language of "14 g/m²"

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 171, 174.

Thus, in the absence of any evidence or showing to the contrary, it remains the Examiner's position that Applicant's claimed invention is rendered obvious over the prior art of record discussed above.

Art Unit: 1772

CONCLUSION

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (703) 305-0582. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:30 p.m. The Examiner can also be reached on alternate Fridays.

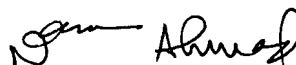
If the attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ellis P. Robinson can be reached by dialing (703) 308-2364. The fax phone number for the organization where this application is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose phone number is (703) 308-0661.

jif



December 27, 1999


NASSER AHMAD
PRIMARY EXAMINER
~~GROUP 1300~~
TC-1700